

REMARKS

No claims have been added, canceled or amended. Claims 1-48 remain pending in the application.

Rejection of Claims 18-34 Under 35 U.S.C. § 101

The Examiner has again rejected Claims 18-34 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Reconsideration and withdrawal of the rejection is respectfully requested.

The Examiner has attempted to support his rejection by relying on a series of cases from the Court of Customs and Patent Appeals: In re Waldbaum, 173 USPQ 430 (C.C.P.A. 1972), In re Musgrave, 167 USPQ 280 (CCPA 1970), and In re Johnston, 183 USPQ 172, reversed by, Dann v. Johnston, 425 U.S. 219, 96 S.Ct. 1393 (1976). None of these cases held that claims such as Applicant's claims lacked statutory subject matter. Moreover, to the extent such decisions of the Court of Customs and Patent Appeals are inconsistent with it, the Federal Circuit's decision in AT&T Corp. v. Excel Communications, 172 F.3d 1352 (Fed. Cir. 1999) is controlling. The Examiner also cites Ex Parte Bowman, 61 USPQ2d 1669 (Board of Pat. App. & Int. 2001). However, Bowman is a Board of Patent Appeals and Interferences decision which is not even precedential as to the Board, much less a binding judicial decision. It simply has no bearing in light of contrary Federal Circuit authority.

The Examiner claims that the facts of AT&T Corp. support his rejection. Specifically, he contends that in AT&T Corp. "technology is cited in the claims." However, the Examiner further states that "If the invention in the body of the claim is not tied to technological art, environment, or machine, the claim is not statutory." The Examiner ignores the fact that the two features of the AT&T Corp. claims which he contends are within the technological arts--"telecommunications system" and "facilities"--are in the preamble of the claim, not the body of the claim. Thus, the facts and holding of AT&T Corp. are directly contrary to the Examiner's position.

Furthermore, the cited CCPA decisions do not hold that a claimed invention must include physical limitations in order to be patentable. As the Examiner points out, In re Waldbum holds that the term "technological arts" is synonymous with the Constitutional requirement that patentable inventions be in the "useful arts." However, the Examiner has interpreted the holding of In re Waldbum as requiring the inclusion of physical limitations, such as a computer or computer network. None of the cited CCPA holdings support that interpretation. Even if they did, however, the AT&T court rejected the requirement of physical limitations, and their decision is controlling. AT&T Corp., 172 F.3d at 1359.

Rejection of Claims 1-7, 9-13, 15, 17-24, 26-30, 32, 34-37, 40-44, 46 and 48 Under 35 U.S.C. § 102(b)

The Examiner has rejected the above-referenced claims as anticipated by Brandt et al., U.S. Patent No. 5,895,905 ("Brandt"). Reconsideration and withdrawal of the rejection is respectfully requested.

Brandt is directed to a computer apparatus and method for providing a common user interface for software applications accessed via the World Wide Web. It also includes a "Car Rental Example." However, it does not disclose the present invention.

Claim 1 recites, inter alia, a method comprising "displaying a reservation summary having reservation information pertaining to the type of equipment reserved and the date of reservation." Brandt does not disclose this claim limitation. In support of his rejection, the Examiner relies on Brandt's disclosure at column 23, lines 64-67. However, that portion of Brandt describes a web browser input form which "requires a user to input his or her member number, last name, first name, middle initial, origin, city, state, start date, number of days, and car preference" in order to request a reservation. Brandt at 23:64-67 (emphasis added). Brandt does not describe displaying a reservation summary as claimed. It merely describes a process for requesting a reservation. Thus, Brandt cannot anticipate Claim 1. Independent Claim 18 similarly recites displaying a reservation summary. Claims 2-17 and Claims 19-34 depend from

Claims 1 and 18, respectively, include additional patentable features, and are allowable over Brandt as well.

Independent Claim 35 recites a reservation field having information pertaining to the type of equipment reserved and the date of reservation. Brandt's does not disclose a reservation field for equipment that has been reserved. At most, it discloses a reservation field for requesting a reservation. Nor does Brandt disclose a scope selector wherein the reservation field provides information pertaining to a selected scope criteria, as recited in Claims 36 and 37.

Dependent Claim 41 recites a search field that includes a search request window, wherein the search field returns information pertaining to search request upon the activation of a search. As the Examiner points out, Brandt discusses searching for equipment, generally. Brandt at 29:60-30:5. However, Brandt does not disclose a search request window as claimed. The other claims depending from Claim 35 include additional patentable features and are allowable as well.

Rejection of Claims 6,9,23 and 26 Under 35 U.S.C. § 103(a) as Obvious Over Brandt in view of Ryder Internet Publication

The Examiner has rejected Claims 6, 9, 23 and 26 as obvious based on the combination of Brandt and a Ryder Internet Flyer. The combined references do not disclose or suggest all of the limitations of the rejected claims and cannot render them

obvious.

Claims 6 and 9 depend from Claim 1, and Claims 23 and 26 depend from Claim 18. The Examiner relies on the Ryder flyer for its disclosure of one-way truck rental. The flyer merely says "Save 10% On All One-Way Rentals." It does not address reservation or equipment tracking and does not disclose displaying a reservation summary. Thus, Claims 6, 9, 23 and 26 are allowable over the combination of Brandt and the flyer for the same reasons that Claims 1 and 18 are allowable over Brandt.

In addition, the Examiner has not identified a motivation or suggestion in the prior art for combining Brandt and the flyer to reject Applicant's claims. While the Examiner asserts that "it is important for vehicle tracking to determine if a rental truck will be returned to the original vendor or a different vendor," there is no evidence that the prior art recognized such a need. Without a proper prior art suggestion or motivation for combining the references, the rejection is improper and should be withdrawn. "When an obviousness determination is based on multiple prior art references, there must be a showing of some teaching, suggestion, or reason to combine the references." Winner International Royalty Corp. v. Wang, 202 F.3d 1340, 1348 (Fed. Cir. 2000) (citations omitted). See also In re Stencel, 828 F.2d 751, 755 (Fed. Cir. 1987) ("Nor is obviousness established by combining the teachings of the

prior art to produce the claimed invention, absent some teaching or suggestion that the combination be made").

**Rejection of Claims 8, 25, 38 and 39 as Obvious Under
35 U.S.C. § 103(a) Over Brandt in View of Craig**

The Examiner has rejected claims 8, 25, 38 and 39 as obvious under 35 U.S.C. § 103(a) based on the combination of Brandt and Craig, et al., U.S. Patent No. 6,266,809 ("Craig"). Claim 8 depends from Claim 1. Claim 25 depends from Claim 18, and Claims 38 and 39 depend from Claim 35. In addition to those limitations recited in the corresponding independent claims, the rejected claims recite additional limitations directed to alerting users when the claimed system fails to update reservation and/or equipment information as claimed. The combined references fail to disclose or suggest the limitations of the rejected claims and cannot render them obvious.

The portion of Craig relied upon discloses alerting a network administrator when a firmware update has failed. Craig at 7:49-8:2. However, Craig does not compensate for the deficiencies of Brandt. Thus, Claims 8, 25, 38 and 39 are allowable over the combination of Brandt and Craig for the same reasons that Claims 1, 18 and 35 are allowable over Brandt.

Further, Craig deals with firmware updating, not updating reservation and/or equipment information. On this basis

as well, the combined references do not disclose the claimed invention. Moreover, the Examiner has not identified any suggestion or motivation in the prior art for combining Craig with Brandt to obtain the claimed invention. Thus, the combination is improper, and the rejection should be withdrawn.

Rejection of Claims 14, 31 and 45 as Obvious Under 35 U.S.C. § 103(a) Over Brandt In View of Sehr

The Examiner has rejected Claims 14, 31 and 45 as obvious Under 35 U.S.C. § 103(a) based on the combination of Brandt and Sehr, U.S. Patent No. 6,085,976 ("Sehr"). Sehr is directed to a travel system utilizing multi-application passenger cards. Sehr does not address equipment rental or reservations, much less methods or systems for tracking them. The Examiner relies on Sehr for its disclosure concerning displaying payment information.

Claim 14 depends from Claim 1, and additionally recites the step of displaying payment information. Claims 31 and 45 are similarly directed to this feature and depend from Claims 18 and 35, respectively. Because it contains no disclosure concerning equipment rental or reservations, Sehr does not compensate for Brandt's deficiencies. Therefore, Claims 14, 31, and 45 are allowable over the combination of Brandt and Sehr for the same reasons that Claims 1, 18 and 35 are allowable over Brandt. Moreover, the rejection is also improper because no prior art

suggestion or motivation for combining Brandt and Sehr has been identified. Thus, reconsideration and withdrawal of the rejection is respectfully requested.

**Rejection of Claims 16, 33 and 47 as Obvious Under 35
U.S.C. § 103(a) Over Brandt in View of Jaun**

The Examiner has rejected Claims 16, 33 and 47 as obvious under 35 U.S.C. § 103(a) based on the combination of Brandt and Jaun, U.S. Patent No. 5,344,172 ("Jaun"). Claims 16, 33, and 47, depend from Claims 1, 18 and 35, respectively, and recite additional limitations directed to verifying the compatibility of a requested towing combination.

Jaun is directed to a trailer hitch assembly system. However, it does not address managing, or tracking rental equipment. Because Jaun does not compensate for Brandt's deficiencies, Claims 16, 33 and 47 are allowable over the combination of Brandt a Jaun for the same reasons that Claims 1, 18 and 35 are allowable over Brandt.

CONCLUSION

In view of the foregoing, it is believed that all claims now pending patentably define the subject invention over the prior art of record and are in condition for allowance and such action is earnestly solicited at the earliest possible date.

Respectfully submitted,

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